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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,235	06/11/2002	Jaak Decuypere	DCLQ:003	5573

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EXAMINER
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MARX, IRENE

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/009,235

**Applicant(s)**

DECUYPERE ET AL.

**Examiner**

Irene Marx

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

The amendment filed 12/2/04 is acknowledged. Claims 1-12, 14 and 20-21 are being considered on the merits.

Claims 15-19 are withdrawn from consideration as directed to a non-elected invention.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 8, 14 and 20-21 are rejected under 35 U.S.C. 101 because this claim reads on a product which is found in nature and thus, is unpatentable to applicant. Consequently, the claim does not embody patentable subject matter as defined in 35 USC 101. See, e.g., *American Wood v. Fiber Disintegrating Co.*, 90 U.S. 566 (1974); *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1 (1931); *Funk Brothers Seed. Co. v. Kalo Inoculant Co.*, 33 U.S. 127 (1948); *Diamond v. Chakrabarty*, 206 U.S.P.Q. 193 (1980).

Claims 1-5, 8, 14 and 20-21 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

Claims, as written, do not sufficiently distinguish over naturally occurring compositions, because the claims do not particularly point out any non-naturally occurring differences between the claimed products and the naturally occurring products. In the absence of the hand of man, the naturally occurring products are considered non-statutory subject matter. See *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). The claims should be amended to indicate the hand of the inventor as taught by pages 3 and 4 of specification. See MPEP 2105.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 14 and 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 is vague and indefinite in the recitation of “at least one triglyceride” and subsequent recitation of “comprises about 0.25 to about 10% triglyceride”. It is at least ambiguous whether the amount pertains to each of the last least one triglyceride or it is the total amount. In addition the amount of “ppm” for the enzyme is confusing. Generally enzymes are characterized by units of activity rather than by concentration.

Claims 9-12 fail to find proper antecedent basis in claim 1 for “said lipolytic”.

Claims 4-8, 12 fail to find proper antecedent basis in claim 1 for “said lipolytic”. CF. also amended claim 14.

Claim 20 is vague and indefinite in the recitation of “for production animals and companion animals”. The intended target animals are uncertain. For example, the product produced by early weaned piglets is not clearly delineated.

Claim 20 is incomplete in depending on a cancelled claim. Also the recitation should be “any one of claims...”.

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 1-5, 8-11 and 20-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by breast milk from humans and other animals as evidenced by Tang *et al.* and Hurley.

The claims are directed to nutritional composition containing at least one triglyceride containing one or more C4-12 medium chain fatty acids and at least one active lipolytic enzyme, comprising about 0.25 to about 10 % triglyceride and about 100 to about 10,000 ppm lipolytic enzyme.

Breast milk contains about 4% triglycerides as evidenced by Hurley and naturally contains about 100 ppm (0.1 mg/ml) of active bile-salt activated lipase among the lipases in the composition.

Claims 1-12, 14 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hull *et al.* taken with Haas *et al.* and Tang *et al.*

Each of the Hull and Haas references discloses a composition suitable as a feed comprising medium chain fatty acids and one or more lipolytic enzymes. See, e.g., col. 2, lines 23-61 and Example, III, Table II, respectively. The references differ from the claimed invention in that the enzymes are not necessarily "active". However, Tang *et al.* disclose the benefits of providing an active lipolytic enzyme such as bile-salt activated lipase in a feed composition for animals (See, e.g., Table III). The material is provided in conjunction with milk in Tang *et al.*. One of ordinary skill in the art would have had a reasonable expectation of success of providing the same benefits of an active enzyme in any other feed composition containing triglycerides containing medium chain fatty acids, including the enzyme esterase, in view of the benefits of providing medium chain fatty acids *in situ*.

The intended methods of using the same feed compositions as a medicament, an antimicrobial and to prevent digestive upsets does not change the composition itself, which is taught by the references. Its properties are the same regardless of the intent. Similarly, the various method of making triglycerides recited do not materially modify the triglyceride composition obtained thereby.

Furthermore, the composition is claimed as a product-by-process. Since the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make comparisons therewith, a lesser burden of proof is

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required to make out a case of *prima facie* anticipation/obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional manner. MPEP 2113.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the medium chain fatty acid containing compositions of Hull *et al.* and Haas *et al.* by providing active lipolytic enzymes as suggested by the teachings of Tang *et al.* for the expected benefit of providing free medium chain fatty acids *in situ* by degrading the triglycerides provided, which medium chain fatty acids have well recognized antimicrobial and digestive properties.


Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Irene Marx  
Primary Examiner  
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